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EXAMINER
CHIANG, JACK

ART UNIT	PAPER NUMBER
2642	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PRG

Office Action Summary

Application No.	Applicant(s)	
09/192 303	M. Deguchi	
Examiner	Group Art Unit	
T Nhiang	2642	#20

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 2-7-02.

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 24-30, 36-40, 42-43, 45-48 is/are pending in the application.

Of the above claim(s)_____ is/are withdrawn from consideration.

☐ Claim(s)_____ is/are allowed.

☒ Claim(s) 24-30, 36-40, 42-43, 45-48 is/are rejected.

☐ Claim(s)_____ is/are objected to.

☐ Claim(s)_____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on_____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on_____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number)_____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received:_____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s)._____

☒ Notice of References Cited, PTO-892

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Interview Summary, PTO-413

☐ Notice of Informal Patent Application, PTO-152

☐ Other_____

Office Action Summary

CLAIMS

112 First Paragraph Rejection

1. Claims 36-40, 42, 47 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In claim 36, it claims a first key section having a movement key and an execution key, this appears referring to keys 103-104 in fig. 1. It further claims said movement key and said execution key are operated without requiring a user to substantially reposition a user body part that contacts said first key section. This is questionable. In fig. 1, in order to operate keys 103 and 104, the user's finger has to be repositioned in a normal operation. In order to operate the movement and execution of the cursor without reposition the user's finger, it has to be fig. 7. However, figs. 1 and 7 are two different embodiments, and claim 36 is claiming features and operations in these two embodiments in one single device. This is unsupported and can also be considered as a new matter.

Art Rejection

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 24-28, 30, 36-39, 42-43, 46-48 , as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Nelson (US 5710605).

Regarding claim 24, Nelson shows:

Displaying, in a first user interface (i.e. display 20) on a housing (10) having a second user interface (i.e. 34) on the same side as the first interface, a menu having items (14 in fig. 1, see also fig. 7) and a highlight bar (47);

Moving four-way movement of a highlight bar (52, 58, 60, 62);

Executing the selected item (50); and

Said moving and executing is performed without substantially repositioning the user's finger (see, 50, 52, 58, 60, 62 in fig. 1).

Regarding claim 36, Nelson shows:

A display section (i.e. 20);

A key section (i.e. 50-88);

A first key section including a movement key pad which moves a highlighted portion (52, 58, 60, 62), and an execution key (50);

A second key section including a ten key pad (see 88);

The display section (20) displays items in rows and columns (see 14 in fig. 1, see also fig. 7);

The movement key allows four-way movement and items on a column to be scrolled (see 52, 58, 60, 62); and

Said moving and executing is performed without substantially repositioning the user's finger (see, 50, 52, 58, 60, 62 in fig. 1).

Regarding claim 43, Nelson shows a method for selecting one of the items displayed in rows and columns comprising:

Moving a highlighted portion (47) in four directions by a movement key (52, 58, 60, 62), only items on the column is allowed to be scrolled (see 14 in fig. 1, see also fig. 7);

Executing the highlighted portion by an execution key (50); and

Said moving and executing is performed without substantially repositioning the user's finger (see, 50, 52, 58, 60, 62 in fig. 1).

Regarding claims 25-28, 30, 37-39, 42, 46-48, Nelson shows:

Scrolling the highlight bar, the memory, and items on the display (see 14 in fig. 1, see also fig);

Reading and arranging the data (see 14 in fig. 1, see also fig. 7);

Selecting and executing a communication address (see 14 in fig. 1, see also fig. 7);

The executing and communicating with another device (col. 3, lines 42-58);

The first key section which has the movement key and the execution key (50, 52, 58, 60, 62);

The movement key having plurality of keys (52, 58, 60, 62);

the execution key which is sandwiched by contacts of the movement key (50); and

the first and second key sections are in one housing (see 50, 52, 58, 60, 62).

Said moving and executing is performed without substantially repositioning the user's finger (see, 50, 52, 58, 60, 62 in fig. 1).

3. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Nelson in view of Ohkura et al. (US 5737029) or JP6-232992.

Regarding claim 40, Nelson shows the movement and execution key (see 50, 52, 58, 60, 62).

Nelson differs from the claimed invention in that it is not the single lever-type key which is inclined and depressed to close the contacts.

However, Ohkura and JP6-232992 both providing the single lever-type key which is inclined and depressed to close the contacts (see 52 in Ohkura; 202-205 in fig. 2; see also equivalent key operation in 402-406 in fig. 4 in JP6-232992). Hence, it would have been obvious for one skilled in the art to replace the key of Nelson with the single lever-type key shown by Ohkura or the JP reference. This can be considered as an intended use of Ohkura or the JP reference. It is also understood that all of these references

(Nelson, Ohkura and JP6-232992) disclose the combination of the movement key and the execution key, and replacing one type of key with the other can be considered as a variation of each other, because the basic requirement for moving the cursor (movement key) and executing the key is substantially unchanged.

4. Claims 29 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of August et al. (US 5671267).

Regarding claims 29 and 45, Nelson shows a portable device (10).

Nelson differs from the claimed invention in that it is not a telecommunication device which has user interface transmitting sound waves.

However, Nelson's portable device has a remote control function, and remote control and telephone handset are commonly integrated as a single unit, this is shown by August (see 10 in fig. 1). Hence, it would have been obvious for one skilled in the art to modify Nelson's remote control unit with a telephone feature as taught by August, such that to combine telephone and remote control as a single unit to provide control functions for remotely operated devices (col. 1, lines 7-12 in August).

5. Claims 24-30, 36-40, 42-43, 45-48 are, as best understood, rejected under 35 U.S.C. 103(a) as being unpatentable over JP5-244241 in view of Nelson or Ohkura et al.

Regarding claim 24, 43, JP5-244241 shows:

Displaying, in a first user interface (i.e. display 4) on a housing (1) having a second user interface (i.e. 10) on the same side as the first interface, a menu having items and a highlight bar , only items on the column is allowed to be scrolled (see 4);

Moving four-way movement of a highlight bar (7).

Executing the highlighted portion (8).

JP5-244241 differs from the claimed invention in that the user needs to move his finger between the movement key and the execution key (7-8).

However, Nelson and Ohkura both teach a movement key and an execution key which can be operated without substantially reposition the user's finger (50, 52, 58, 60, 62 in Nelson; 52 in Ohkura).

Hence, it would have been obvious for one skilled in the art to replace the movement key and the execution key of the JP5-244241 with the movement key and the execution key shown by Nelson and Ohkura. This can be considered as an intended use of Nelson and Ohkura. It is also understood that all of these references (JP5-244241, Nelson and Ohkura) disclose the combination of the movement key and the execution key, and replacing one type of key with the other can be considered as a variation of each other, because the basic requirement for moving the cursor (movement key) and executing the key is substantially unchanged.

Regarding claim 36, JP5-244241 shows:

A display section (i.e. 4);

A first key section including a movement key pad which moves a highlighted portion (7) and an execution key (8);

The display section (4) displays items in rows and columns (see 4);

The movement key allows four-way movement and items on a column to be scrolled (see 4).

JP5-244241 differs from the claimed invention in that the user needs to move his finger between the movement key and the execution key (7-8).

However, Nelson and Ohkura both teach a movement key and an execution key which can be operated without substantially reposition the user's finger (50, 52, 58, 60, 62 in Nelson; 52 in Ohkura).

Hence, it would have been obvious for one skilled in the art to replace the movement key and the execution key of the JP5-244241 with the movement key and the execution key shown by Nelson and Ohkura. This can be considered as an intended use of Nelson and Ohkura. It is also understood that all of these references (JP5-244241, Nelson and Ohkura) disclose the combination of the movement key and the execution key, and replacing one type of key with the other can be considered as a variation of each other, because the basic requirement for moving the cursor (movement key) and executing the key is substantially unchanged.

JP5-244241 further differs from the claimed invention in that it does not have a ten key pad.

However, both Nelson and Ohkura also teach a ten key pad (88 in Nelson; see fig. 23 in Ohkura).

Hence, it would have been obvious for one skilled in the art to modify JP5-244241 with a ten key pad as taught by Nelson and Ohkura, such that to provide the user with an option of directly entering information into the device (col. 5, lines 46-62 in Nelson,

Regarding claims 25-30, 37-40, 42, 45-48, the combination of JP5-244241, Nelson and Ohkura shows:

Scrolling the highlight bar, the memory, and items on the display (see 4 in JP5-244241);

Reading and arranging the data (see 4);

Selecting and executing a communication address (see 4);

The executing and communicating with another telecommunication device (1);

sound transmitting interface (10);

the movement key and the execution key (see Nelson and Ohkura);

The movement key having plurality of keys (see Nelson and Ohkura);

the execution key which is sandwiched by contacts of the movement key (see Nelson and Ohkura);

the first and second key sections are in one housing (see JP5-244241,Nelson and Ohkura);

Said moving and executing is performed without substantially repositioning the user's finger (see Nelson and Ohkura).

ARGUMENT

6. In response to the remarks, pages 4-10, Sudo and its combination are withdrawn in view of the amendment. New references are cited, argument is answered in the rejection above, see rejection above.

7. Applicant's arguments with respect to claims 24-30, 36-40, 42-43, 45-48 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 703-305-4728. The examiner can normally be reached on Mon.-Fri. from 8:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Admad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Jack Chiang
Primary Examiner
Art Unit 2642